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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,930	09/19/2001	Tsuyoshi Hiramatsu	3273-0146P	3012
2292	7590	10/15/2003		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER CHANG, VICTOR S	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/936,930	HIRAMATSU ET AL.	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1,5-7 and 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4,8 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 7/28/2003. Applicant's amendments to the Abstract and claims 2 and 4, and newly added claims 20-23 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Election/Restrictions

4. The Examiner notes that claim 9 does not belong to elected species B, which was inadvertently included in the prior Office action of Paper No. 10, according to Applicants' response to Restriction Requirement filed 12/18/2002. As such, the Examiner now notes that claim 9 is withdrawn as non-elected species.

Response to Amendment

5. Claims 2-4, 8 and 20-23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. It is noted that the composition of the adhesive is critical or essential to the practice of the invention, but not included in the independent claims 2 and 3 is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The Examiner repeats (see Paper No. 10, page 3) that the composition of the adhesive which effects the specific interactions (e.g., the solvent absorption rate and tackiness) between the adhesive and solvent is critical or essential to the practice of the invention, and the absence of a specific genus of composition of suitable adhesives in the claims renders the instant claimed invention in excess of its provided disclosure.

With respect to Applicants' Remarks arguing that one of ordinary skill in the art can readily carry out the claimed invention in view of the disclosure in the Specification (Response, pages 6-7, bridging paragraph), it should be noted that although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. See *In re Van Geuns*, 988 f.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, claims 2 and 3, lines 4-10 of each claim, recites "wherein the pressure sensitive adhesive layer absorbs 5 g/m² or more of a solvent contained in the substance to be removed when the pressure sensitive adhesive sheet is immersed in the solvent for 1 second", however, nowhere in the Specification is it taught how to control the rate of solvent transfer from the "substance" to be removed to the adhesive layer. Further, it appears that Applicants only claim is to remove a "substance" containing greater than 5 g/m² or more of a solvent, which appears to be inconsistent with the preamble at lines 1-2, which recites in part "for removal of a solvent-containing substance". Also, it appears that the recitation is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

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6. Claims 2, 8 and 20-23 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that newly amended claim 2, lines 3-4, now recites in part "excluding a foaming pressure sensitive adhesive layer". However, Applicants have not pointed out any express or inherent support in the Specification. As such, the aforementioned amendment appears to be "new matter", and cancellation is required. Additionally, it is noted that inherently "excluding a foaming pressure sensitive adhesive" is equivalent to "free of a foaming pressure sensitive adhesive", which is new matter under the rule of *Ex Parte Grasselli et al.* – Bd. of App. 231 PQ 393, Affd. 738 F. 2d 453 (Fed. Cir. 1984) to the effect that limitations such as "free of" a particular element are new matter in the absence of express support.

7. Claims 2-4, 8 and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are narrative in form and replete with indefinite and functional or operative language. For example,

The Examiner repeats (see Paper No. 10, page 3) that the recitation in claim 2, lines 4-10, "wherein the pressure sensitive adhesive layer absorbs 5 g/m² or more of a solvent contained in the substance to be removed when the pressure sensitive adhesive

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sheet is immersed in the solvent for 1 second, and wherein the pressure sensitive adhesive sheet after absorbing 5 g/m^2 of the solvent has a tackiness of 1 cN/25-mm or more" is vague and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in fact, recites compounds by what it is desired that they do rather than what they are. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

Further, in the absence of a teaching of how the solvent is transferred out of or removed from the "substance", as set forth above, it is vague and indefinite as to what is the scope of the "substance" to be removed.

Additionally, it is unclear what is the relation between "wherein the pressure sensitive adhesive layer absorbs 5 g/m^2 or more of a solvent contained in the substance to be removed" and "when the pressure sensitive adhesive sheet is immersed in the solvent for 1 second". Clarification is requested.

Finally, in newly amended claim 4, lines 4-5, it appears that the phrase "comprised of ... comprised solely of" is vague and indefinite, i.e., it appears claiming "solely" in an open transitional clause after "comprising" is inconsistent and confusing.

8. Claims 2-4, 8 and newly added 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art, substantially for the reasons set forth in section 7 of Paper No. 10, together with the following additional observations.

First, the Examiner notes that newly amended claim 2 appears to recite "new matter" of "excluding a foaming pressure sensitive adhesive layer", which should be cancelled, as set forth above. Additionally, the Examiner notes that even if the

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aforementioned amendment is not "new matter", in the absence of unexpected results, it appears that the prior art rejection is still deemed to be proper.

It is also noted that Applicant's Remarks admitted (page 8, bottom paragraph) that "JP 3-74893 teaches ... a pressure sensitive adhesive layer has a tack of from 100 to 300 g/25-mm."

With respect to Applicant's response arguing that "However, even though such pressure sensitive adhesive layers exhibit such properties, the solvent adsorption, the tack after absorption, and other properties ... are not inherent in a pressure sensitive adhesive sheet having the tack disclosed in the reference" (Remarks, page 8, bottom paragraph), the Examiner repeats (see Paper No. 10, section 7) that Applicants appear to have admitted that a pressure sensitive adhesive sheet for removing a solvent containing paste, such as the excess ink at the back of the printing plate, is known (Specification, page 3, lines 3-21). Although the prior known art does not expressly teach the solvent absorption property and tackiness after absorbing the solvent, it is believed that a suitable adhesive which absorbs solvent and retains sufficient tackiness are either inherently disclosed or an obvious selection to one of ordinary skill in the art, motivated by the desire to remove the excess ink, as taught by the prior known art.

Applicants' arguments that "none of the references take any notice of or give any consideration to the properties of the pressure sensitive adhesive layer relative to the solvent present in inks" and "the references also fail to disclose or suggest the importance of the absorption amount of solvent included in inks and the tack after solvent absorption" (Remarks, page 9, first full paragraph) are not persuasive. The

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Examiner asserts that solvent is inherently present in the inks removed by the adhesive tape, as taught by JP 3-74893. As such, a suitable adhesive which absorbs solvent and retains tackiness for removal is believed to be either inherently disclosed, or an obvious optimization to one skilled in the art. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

For newly added claims 20-23, the Examiner notes that the newly recited monomers, polymers and crosslinking agent are well known and conventional elements for a pressure sensitive adhesive. As such, the Examiner reiterates that, in the absence of unexpected results, it would have been obvious to one skilled in the art to select a suitable adhesive based on aforementioned monomers, polymers and crosslinking agent, which absorbs solvent and retains tackiness for removal, as taught by the prior art.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900
1700

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